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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,445	04/14/2000	Becki Speakman	70015060.02	8917

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11/29/2001

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EXAMINER

MOHAMEDULLA, SALEHA R

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 11/29/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

JD-6

Office Action Summary	Application No. 09/549,445	Applicant(s) SPEAKMAN, BECKI	
	Examiner Saleha R. Mohamedulla	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-9, in Paper No. 5 is acknowledged. Claim 10 is withdrawn from consideration.

Claim Objections

2. Claim 6 is objected to because of the following informalities: in line 8, it appears "repeat" should be "repeating." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "predetermined portion" in line 12. The specification does not define what is meant by "predetermined." Therefore, it is unclear as to what is meant by this limitation. Claims 2-5 are rejected as being dependent on claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by US# 5,460,087 to Ogorzalek

Ogorzalek teaches a stencil template fabricated from a closed cell foam with a stiff backing. The template has one smooth surface and a contact surface with a temporary stick mastic (col. 1, lines 55-60). The contact surface is allowed to adapt to a textured surface while the mastic provides a sealing that prevents paint from migrating under the template when applied to a surface (col. 1, lines 60-64). The mastic that forms the contact surface will repeatedly adhere to a structural surface to which paint is to be applied (col. 2, lines 23-25). Figure 4 shows the stencil. The stencil template 14 is fabricated from a closed cell foam material with a smooth top surface 50, a bottom contact surface 52 coated with an adhesive for repeatedly adhering the template to a wall surface 48 of a structure 36 as shown in Figure 5 (col. 3, lines 26-33). Claim 1 of Ogorzalek recites that the template has cut-outs through which paint is applied to a surface to which the template is adhered. Figures 1, 2 and 5 show various designs made by the cut-outs. Ogorzalek also teaches that a protective, peel-off paper may be applied to the removable-type adhesive side of the stencil (col. 4, lines 27-31). Therefore, Ogorzalek teaches a mask (stencil template) having an outer surface (smooth surface) and an inner surface (contact surface). The inner surface has an adhesive disposed thereon (mastic) and a backing removably affixed to the

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mask at the inner surface (protective, peel-off paper). Ogorzalek also teaches a plurality of designs formed in the mask by the cut-outs. Ogorzalek teaches that the templates have die-cut and feature designs that can be repeated by repeatedly applying and moving the template along the length of the intended ornamentation (col. 2, lines 4-9). Therefore, Ogorzalek also teaches that the template is adapted to be removably attached to a surface at the inner surface (contact surface). Because the template can be repeatedly applied and moved, the template is selectively dispensable to continuously cover a portion of the surface. As shown in Figure 1, stencil 14 has a plurality of designs formed within an interior portion of the mask. These designs are cut-out portions, therefore, when paint is applied a positive image is formed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US# 5,460,087 to Ogorzalek in view of US# 6,312,872 to Murphy et al.

Ogorzalek teaches the limitations discussed above in paragraph 4, but does not teach or suggest that a plurality of designs repeat along a portion of the mask, or that designs are formed along an outer perimeter of the mask. Ogorzalek also does not teach that the apparatus is a roll. Murphy teaches a relief image printing plate. Murphy teaches preparing composite printing elements without the need for individual registration of relief image elements and without the

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need for compensating for elongation due to cylindrical mounting (col. 2, lines 20-25). In one embodiment, Murphy teaches that the printing plate may be cylindrical as shown in Figure 6 (col. 3, line 65 – col. 4, line 10). Therefore, Murphy teaches that the printing plate may be a roll. Because Murphy teaches relief elements, Murphy teaches that a negative image is transferred to a surface. Figures 9 and 14 show exemplary designs on the printing plate. Figure 14 shows a repeating pattern on the left and right sides of the cylinder. Figure 9 shows a repeating pattern of circles. Therefore, Murphy teaches that a plurality of designs repeat along a portion of the mask. Murphy does not specifically teach forming designs along an outer perimeter, however, one of ordinary skill in the art would realize that Murphy envisions embodiments where designs are placed in the outer perimeter because Murphy teaches that individual registration of the designs or elements is not needed (col. 2, lines 20-25).

The references are analogous art as they are drawn to transferring images by applying masks to a surface. It would have been obvious to one of ordinary skill in the art to use the pattern and cylinder of Murphy with the mask of Ogorzalek in order to prepare printing elements without the need for precise registration (Abstract).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Saleha Mohamedulla whose telephone number is (703) 308-1260. The Examiner can normally be reached Monday-Friday, from 8:00 AM to 4:30 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this

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application or proceeding is assigned is (703) 872-9310. The After Final fax phone number is (703) 872-9311. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

srm



November 17, 2001



MARK F. HUFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700